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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,702	12/31/2001	Jayantilal Devabhai Patel	1477	4988

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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,702

Applicant(s)

PATEL, JAYANTILAL DEVABHAI

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 43-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 43-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-2 and 43-64 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The objection to claims 43-44, 46-50, 52-53 and 55-61 because of informalities is withdrawn in light of Applicant's amendment to the claims.
4. The rejection of claim 61 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements is withdrawn in light of Applicant's amendment to the claims.

Claim Rejections - 35 USC § 112

5. Claim 64 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Neither the instant specification nor the originally filed claims appear to provide support for the phrase “wherein the second canola plant has nuclear male sterility” in line 4. Thus, such a phrase constitutes NEW MATTER. In response to this rejection, Applicant is required to point to support for the phrase or to cancel the new matter.

6. Claims 46, 49-50, 55 and 60 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The

rejection is repeated for the reasons of record as set forth in the Office action mailed 19 March 2004, as applied to claims 1-2 and 43-61. Applicant's arguments filed 18 June 2004 have been fully considered but they are not persuasive.

Claims 46 and 55 are indefinite because the members of the Markush group are not tissue types, but rather are plant parts, and hence do not further define "tissue".

Applicant urges that the claims recite tissue types as defined on pg 24 of the specification (response pg 7).

This is not found persuasive because pg 24, lines 18-22 state: "This invention is also directed to the use of 45A55 in tissue culture. As used herein, the term plant includes plant protoplasts, plant cell tissue cultures from which canola plants can be regenerated, plant calli, plant clumps, and plant cells that are intact in plants or parts of plants, such as embryos, pollen, ovules, seeds, flowers, kernels, ears, cobs, leaves, husks, stalks, roots, root tips, anthers, silk and the like." Thus, the specification specifically uses the term "plant parts" and does not define tissues as plant parts. It is suggested that "tissue" be replaced with --plant part--.

Applicant urges that the claim is directed to a tissue culture wherein the cells of the tissue culture are from a tissue, and thus do adequately define tissue (response pg 7).

This is not found persuasive because pods, flowers, and leaves, etc are made up of many types of tissues but are not themselves tissues.

Claims 49-50 are indefinite in their recitation of "parent is designated 45A55, ... PTA-5684". This is confusing, but it is unclear if the claims are intended to indicate that 45A55 is the male or female parent in the cross or if 45A55 is crossed to itself. In the latter case, the claims are not properly dependent upon claim 48, in which 45A55 is crossed to a different canola plant.

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If the former, wherein the ... PTA-5684” should be replaced with --, wherein 45A55 is the female parent-- in claim 49 and --, wherein 45A55 is the male parent-- in claims 50.

Applicant urges that the claims have been amended as suggested (response pg 7).

This is not found persuasive because the claims have not been so amended.

Claim 60 lacks antecedent basis for the limitation “said first generation (F1) canola variety 45A55 progeny canola plant” in part (b).

Applicant urges that there is proper antecedent basis in line 1 in the phrase “said first generation (F1) canola variety progeny canola plant” (response pg 7).

This is not found persuasive because “45A55” is missing from that phrase.

Double Patenting

7. Claims 1-2 and 43-61 remain rejected and claims 62-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,639,131. Although the conflicting claims are not identical, they are not patentably distinct from each other. The rejection is repeated for the reasons of record as set forth in the Office action mailed 19 March 2004, as applied to claims 1-2 and 43-61. Applicant’s arguments filed 18 June 2004 have been fully considered but they are not persuasive.

Applicant urges that the claims are patentably distinct because they involve a novel canola seed, plants, plant parts and methods (response pg 8).

This is not found persuasive because the canola plants claimed in the instant application, 45A55, and the canola plants of claimed in ‘131, 45A54, have the same traits including flower color (yellow), shedding pollen, plant type (spring), and presence of blackleg and white rust

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resistance, for example. The canola plants also share similar scores on traits that are affected by environment, *e.g.*, flowering date, plant height, and seed weight, relative to standard canola lines. Thus, the plants appear to be identical. Applicant has provided no evidence to the contrary.

Applicant urges that the use of the designation "45A55" is not arbitrary and defines a canola variety that has been deposited under an ATCC accession number; one of skill in the art would understand the two plants to be distinct and unrelated (response pg 8).

This is not found persuasive because there is nothing to prevent two identical plants being given different designations. Applicant has provided no Declaration evidence showing that the two plants are not identical.

Applicant urges that amending the claims to include the accession number makes this rejection moot (response pg 8).

This is not found persuasive because there is nothing preventing the same plant from being deposited under different ATCC deposits. Furthermore, different ATCC accession numbers do not make two otherwise identical plants nonidentical.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.
August 30, 2004



**ANNE KUBELIK
PATENT EXAMINER**